



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,233	07/14/2003	Patrick J. Kelly	55474/7	8520

31013 7590 04/09/2007
 KRAMER LEVIN NAFTALIS & FRANKEL LLP
 INTELLECTUAL PROPERTY DEPARTMENT
 1177 AVENUE OF THE AMERICAS
 NEW YORK, NY 10036

EXAMINER

GILLIGAN, CHRISTOPHER L

ART UNIT	PAPER NUMBER
----------	--------------

3626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/620,233

Applicant(s)

KELLY ET AL.

Examiner

Luke Gilligan

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. In the amendment filed 1/16/07, the following has occurred: claims 1, 13, and 20 have been amended. Now, claims 1-20 are presented for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-10, 13-15, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ralston et al., U.S. Patent No. 6,389,454 in view of Dubois et al., Source Localization Following Permanent Transperineal Prostate Interstitial Brachytherapy Using Magnetic Resonance Imaging (hereinafter, Dubois).

4. As per claim 1, Ralston teaches a method for health care screening, comprising: contacting a scheduling service (see column 4, lines 6-12); scheduling an MRI procedure via the scheduling service (see column 4, line 65 – column 5, line 5); determining if the MRI procedure can be authorized (see column 4, line 65 – column 5, line 5); and scheduling the MRI procedure (see column 6, lines 17-22); wherein the scheduling includes selecting a location and an unused time slot for the MRI procedure available between scheduled diagnostic MRI procedures at one of a predetermined set of existing procedure facilities affiliated with the scheduling service as a function of location and time parameters of a user and an availability of the predetermined set of procedure facilities (see column 5, lines 41-60).

5. Ralston does not explicitly teach that the MRI procedure is an abbreviated MRI procedure designed for an asymptomatic individual scheduled with a provider capable of

Art Unit: 3626

performing the abbreviated MRI procedure. However, it is respectfully submitted that abbreviated MRI procedures for asymptomatic individuals along with providers capable of performing them are old and well known in the art as evidenced by Dubois (see page 1 in particular and note that an abbreviated MRI procedure was utilized for the postimplant evaluation). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate abbreviated MRI procedures designed for an asymptomatic individuals scheduled with a provider capable of performing the procedure as a scheduling option into the system of Ralston. One of ordinary skill in the art would have been motivated to incorporate such an option for the purpose of carrying out the objective of effectively and efficiently scheduling appointments with a variety of scheduling options (see column 2, lines 35-40 of Ralston).

6. As per claim 2, Ralston in view of Dubois teaches the method of claim 1 as described above. Ralston does not explicitly teach the MRI procedure includes a T2 type MRI scan. However, the Examiner takes Official Notice that T2 type MRI scans are old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate T2 type MRI scans as a scheduling option into the system of Ralston. One of ordinary skill in the art would have been motivated to incorporate such an option for the purpose of carrying out the objective of effectively and efficiently scheduling appointments with a variety of scheduling options (see column 2, lines 35-40 of Ralston).

7. As per claim 3, Ralston in view of Dubois teaches the method of claim 1 as described above. Ralston does not explicitly teach the MRI procedure is to be performed on a brain of the user of the scheduling service. However, the Examiner takes Official Notice that MRI procedures performed on the brain of a user are old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate MRI

Art Unit: 3626

procedures performed on the brain of a user as a scheduling option into the system of Ralston. One of ordinary skill in the art would have been motivated to incorporate such an option for the purpose of carrying out the objective of effectively and efficiently scheduling appointments with a variety of scheduling options (see column 2, lines 35-40 of Ralston).

8. As per claim 4, Ralston in view of Dubois teaches the method of claim 1 as described above. Ralston further teaches the contacting includes a computer network connection of the user to the scheduling service (see column 4, lines 35-44).

9. As per claim 5, Ralston in view of Dubois teaches the method of claim 1 as described above. Ralston further teaches determining a result of the MRI procedure (see column 7, lines 2-7).

10. As per claim 6, Ralston in view of Dubois teaches the method of claim 1 as described above. Ralston does not explicitly teach the result is determined by a radiologist associated with the procedure facility. However, the Examiner takes Official Notice that MRI procedure results determined by a radiologist are old and well known the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to have results be determined by a radiologist. One of ordinary skill in the art would have been motivated to rely on such a professional for the result to facilitate the provision of services in an efficient, cost-effective manner (see column 2, lines 30-35).

11. As per claim 7, Ralston in view of Dubois teaches the method of claim 6 as described above. Ralston further teaches storing the result by the scheduling service (see column 7, lines 2-7).

12. As per claim 8, Ralston in view of Dubois teaches the method of claim 2 as described above. Ralston further teaches the predetermined set of existing procedure facilities includes a set of existing MRI facilities (see column 4, lines 12-13 and column 5, lines 2-5).

Art Unit: 3626

13. As per claim 9, Ralston in view of Dubois teaches the method of claim 2 as described above. Ralston further teaches the contacting includes contacting the scheduling service via one of a computer network connection and a voice connection (see column 4, lines 36-44).

14. As per claim 10, Ralston in view of Dubois teaches the method of claim 9 as described above. Ralston further teaches the computer network connection includes an Internet connection via a web browser (see column 4, lines 36-44).

15. Claims 13-15, and 18-20 recite substantially similar system and article of manufacture limitations to method claims 1-3 and 9-10 and, as such, are rejected for similar reasons as given above.

16. Claims 11-12 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ralston et al., U.S. Patent No. 6,389,454 in view of Dubois et al., Source Localization Following Permanent Transperineal Prostate Interstitial Brachytherapy Using Magnetic Resonance Imaging (hereinafter, Dubois) and further in view of Pinard et al., U.S. Patent No. 5,940,834.

17. As per claim 11, Ralston in view of Dubois teaches the method of claim 10 as described above. Ralston does not explicitly teach the determining includes presenting at least one web page screen to the user requesting predetermined user personal and medical information.

Pinard teaches a method for generating web pages that includes generating a web page for making reservations for facilities (see column 8, line 66 – column 9, line 5). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the system of Ralston. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of facilitating the provision of services in an efficient, cost-effective manner (see column 2, lines 30-35).

Art Unit: 3626

18. As per claim 12, Ralston in view of Dubois and Pinard teaches the method of claim 11 as described above. Ralston further teaches determining if the MRI procedure can be authorized is performed as a function of the user's predetermined personal and medical information (see column 5, lines 2-5).

19. Claims 16-17 recite substantially similar system limitations to method claims 11-12 and, as such, are rejected for similar reasons as given above.

Response to Arguments

20. In the remarks filed 1/16/07, Applicants argue in substance that paragraph 0003 of the disclosure is not admitted prior art and, therefore, when combined with Ralston fails to teach scheduling an abbreviated MRI procedure designed for an asymptomatic individual.

21. In response to Applicants' arguments, while the Examiner certainly agrees that paragraph 0003 is not an admission of prior art with respect to *scheduling* an abbreviated MRI procedure designed for an asymptomatic individual, it is at least unclear whether it is admitted prior art of the existence of abbreviated MRI procedures. It is important to note that the Examiner never relied upon Applicants disclosure as admitted prior art of *scheduling* and abbreviated MRI procedure, just an admission of the *existence* of abbreviated MRI procedures. It is respectfully maintained that Ralston teaches a method for scheduling an MRI procedure according to the same steps recited in the claims, but merely does not teach applying the scheduling to an abbreviated MRI procedure. Nevertheless, in view of Applicants' amendment to the claims, the Examiner acknowledges that paragraph 0003 of Applicants' disclosure is not evidence of admitted prior art with respect to an abbreviated MRI procedure scheduled with a provider capable of performing the abbreviated MRI procedure. However, based on Applicants' changes to the claims, the Examiner has relied upon the teachings of Dubois and is no longer

Art Unit: 3626

relying on Applicants' disclosure as admitted prior art. Therefore, these arguments are now moot in view of the new grounds of rejection detailed above.

22. It is also noted that Applicants have not traversed the Examiner's taking of Official Notice in the previous Office Action and repeated herein. Therefore, the Examiner takes this lack of a traversal as an admission of prior art. See MPEP 2144.03.

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

24. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3626

27. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

4/2/07


C. LUKE GILLIGAN
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600